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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,481	06/30/2000	Paul Warren Poole	24850A	2284

22889 7590 10/21/2002

OWENS CORNING  
2790 COLUMBUS ROAD  
GRANVILLE, OH 43023

EXAMINER

MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
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1772

8

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/607,481

Applicant(s)

POOLE ET AL.

Examiner

Michael C. Miggins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**REJECTIONS WITHDRAWN**

1. The 35 USC 112 2<sup>nd</sup> paragraph rejection of claims 1 and 9 previously of record in paper #6, page 2, paragraphs 1-3 has been withdrawn.

**REJECTIONS REPEATED**

2. All of the 35 USC 103(a) rejections are repeated for the reasons previously of record in paper #6, pages 2-7, paragraphs 4-8.

**NEW REJECTIONS**

3. There are no new rejections.

**ANSWERS TO APPLICANT'S ARGUMENTS**

4. Applicant's arguments filed 7/10/02 have been fully considered but they are not persuasive.

Applicant's arguments with regard to the 35 USC 112 2<sup>nd</sup> paragraph rejections have been considered but are moot since the rejection has been withdrawn. Applicant's summary of the teachings of Lynn et al. and Nelson in paper #7, pages 3-4 is acknowledged.

Applicant has argued that Nelson teach vibration barrier or pad being made of loaded vinyl, loaded asphalt and asphalt impregnated felt which totally differs from the insulation insert of the present invention as set forth in claim 1 which is selected from a

group of materials consisting of fiberglass, foam, polymer based blanket material, natural fiber based blanket material and combinations thereof. However, Nelson teaches polymer based blanket material since loaded vinyl and loaded asphalt are polymer based blanket materials.

In response to applicant's argument that since Lynn et al. fails to teach or suggest an insert, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Nelson teaches an insert which substantially similar to applicant's and one of ordinary skill in the art would clearly have been motivated to provide the insert of Nelson in the invention of Lynn et al. in order to provide improved noise, vibration and heat insulation in a single insulation pad (see Nelson, column 4, lines 1-40).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's argue on page 5, paper #7, that one of ordinary skill in the art when viewing Figure 5b of Nelson would have it suggested only to provide an insulation insert

of fiberglass between two polymer films which is different than applicant's polymer based blanket layer. However, as stated above teaches polymer based blanket material since loaded vinyl and loaded asphalt are polymer based blanket materials (see column 8, lines 1-5).

Applicant has argued that the examiner has presented no basis or argument to indicate why an artisan would have found it obvious to selectively pick and choose from the various elements and concepts of the two cited references to arrive at the claimed invention without using the present invention as a guide. However, as stated above one of ordinary skill in the art would clearly have been motivated to provide the insert of Nelson in the invention of Lynn et al. in order to provide improved noise, vibration and heat insulation in a single insulation pad (see Nelson, column 4, lines 1-40). One of ordinary skill in the art does not need applicant's disclosure to arrive at the conclusion that providing the insert of Nelson in the invention of Lynn et al. would provide improved noise, vibration and heat insulation in a single insulation pad.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant has argued that the cited prior art of record does not teach an insulation insert encapsulated by a foil and a polymer blanket layer. However, Lynn et al. teach that a metal foil which is a first facing material (column 3, lines 25-40). Nelson teaches the insert comprising polymer blanket material as described above. Thus when the teachings of Lynn et al. and Nelson are combined, applicant's invention is obviated.

Applicant has argued, pages 6-7, paper #7, that none of the secondary references remedy the deficiencies of the combined teachings of Lynn et al. and Nelson. However, since the combined teachings of Lynn et al. and Nelson obviate applicant's claims, the issue of whether or not the secondary references remedy the deficiencies of the combined teachings of Lynn et al. and Nelson is moot.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MCM *[Signature]*  
October 18, 2002

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772* *10/19/02*